

MORRISON & FOERSTER LLP

Attorneys at Law
3811 Valley Centre Drive
Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-5100
Facsimile: (858) 720-5125

To:

NAME:	FACSIMILE:	TELEPHONE:
RENEE PETTUS USPTO - Group Art Unit 1600	703-308-4407	

FROM: David L. Devernoe Reg No. 50,128

DATE: May 8, 2003

Number of pages with cover page:	11	273102007800
----------------------------------	----	--------------

Preparer of this slip has confirmed that facsimile number given is correct: 10065/JAB15

CAUTION - CONFIDENTIAL

This facsimile contains confidential information which may also be privileged. Unless you are the addressee (or authorized to receive for the addressee), you may not copy, use, or distribute it. If you have received it in error, please advise Morrison & Foerster LLP immediately by telephone or facsimile and return it promptly by mail.

Comments:

Application No. 08/812,616

Attorney Docket No. 273102007800

Dear Renee:

Per your conversation with my secretary today, please find attached:

1. Copy of Decision granting Renewed Petition / Request for Reconsideration (paper no. 27), mailed June 7, 2002;
2. Copy of Renewed Petition / Request for Reconsideration, filed May 31, 2002;
3. Copy of Notice of Appeal.

If you need copies of Exhibits A-F, please let us know and we will be happy to forward those to you as well.

Best regards,

David Devernoe



UNITED STATES PATENT AND TRADEMARK OFFICE

COPY
 COMMISSIONER FOR PATENTS
 UNITED STATES PATENT AND TRADEMARK OFFICE
 WASHINGTON, D.C. 20231
 www.uspto.gov

Paper No. 27

KAREN B DOW
 MORRISON & FOERSTER LLP
 3811 VALLEY CENTRE DRIVE
 SUITE 500
 SAN DIEGO CA 92130-2332

COPY MAILED

JUN 07 2002

OFFICE OF PETITIONS

In re Application of
 Boehringer, et al.
 Application No. 08/812,616
 Filed: March 6, 1997
 Attorney Docket No. 273102007800

ON RENEWED PETITION

This is a decision on the renewed petition under 37 CFR 1.137(b), filed on May 31, 2002.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely file a proper response to the non-final Office action mailed September 1, 2000, which set a shortened statutory period for reply of three months. On March 5, 2001, petitioner (through previous counsel) filed an amendment, made timely by obtaining a three month extension of time and including a Certificate of Mailing dated March 1, 2001. A Notice of Abandonment was mailed on May 8, 2001. In response, petitioner filed a petition to withdraw the holding of abandonment on June 23, 2001, citing the timely filed amendment of March 5, 2001. However, this petition was denied in a decision mailed on August 23, 2001.¹ Accordingly, the above-identified application was abandoned as of March 2, 2001.

Petitioner filed a petition to revive under 37 CFR 1.137(b) on January 7, 2002. However, this petition was dismissed in a decision mailed on April 24, 2002. The petition was dismissed because the accompanying amendment failed to *prima facie* place the application in condition for allowance. When filing an amendment in response to a final Office action, only an amendment that *prima facie* places the application in condition for allowance serves as the proper reply under 37 CFR 1.137(b)(1). However, a more careful review of the application file confirms that the Office action mailed on September 1, 2000 was *not* a final Office action. Rather, the September 1, 2000 Office action was a non-final Office action that vacated the previous final Office action mailed on February 23, 2000.

¹ The petition was denied because it was determined that the March 5, 2001 amendment did not constitute a *bona fide* attempt to advance the application to a final Office action.

* No Certification Required *	
Reviewed by Docketing	
Initials	AKL

RECEIVED

JUN 12 2002

MORRISON & FOERSTER
SAN DIEGO

COPY

Application No. 08/812,616

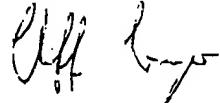
Page 2

With the instant petition, petitioner has met the requirements for a grantable petition under 37 CFR 1.13 (b). The petition fee and the required reply (an amendment) were previously submitted with the earlier petition on January 7, 2002.

The Notice of Appeal submitted with the instant petition has **not** been entered, although a copy will remain in the application file.

The application file is being forwarded to Technology Center 1600 for consideration of the amendment filed January 7, 2002 (paper no. 22).

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0272.



Cliff Congo
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

COPY

PATENT
Docket No. 273102007800

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (703) 308-6916, Attn: Office of Petitions, on May 31, 2002.

Nora Durant
Nora Durant

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Hans BOEHRINGER, et al.

Serial No.: 08/812,616

Filing Date: March 6, 1997

For: QUANTITATIVE LATERAL FLOW
ASSAYS AND DEVICES

Examiner: C. Chin

Group Art Unit: 1641

RENEWED PETITION UNDER 37 C.F.R. § 1.137(b) / REQUEST FOR
RECONSIDERATION UNDER 37 C.F.R. § 1.137(e)

Commissioner for Patents
Washington, D.C. 20231
Attn: Office of Petitions

Dear Sir:

Applicants respectfully request reconsideration of the Decision on Petition, mailed April 24, 2001, and revival of the above identified application. The application was unintentionally abandoned for failure to submit a proper response to the Office action mailed September 1, 2000. The entire delay in filing the required reply from the due date for the reply until the filing of the grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. A Notice of Appeal accompanies this request.

As the Decision on Petition was mailed April 24, 2001 and the present Request for Reconsideration is dated and faxed on May 30, 2002, this request is considered timely filed.

Exhibits A-F are hereby attached as part of the present request for reconsideration.

COPY

I. Applicant's Assertions

The Applicants base the present request to revive, in part, on the following three assertions:

(1) In the Decision on Petition to Revive, mailed April 24, 2002, denying the Petition to Revive, the Office of Petitions stated that the Applicants had failed to reply to a final Office action;

(2) The record as a whole indicates that the only outstanding Office action in the above identified matter is a non-final Office action; and

(3) The Applicants complied with the standard for a Petition to Revive in the Petition mailed November 7, 2001.

II. The Relevant Prosecution Record

A Continued Prosecution Application (CPA) under 37 C.F.R. § 1.53(d) was mailed by Applicants on January 21, 1999. A Response to Missing Parts pertaining to the CPA was mailed on November 29, 1999 and received by the USPTO on December 2, 1999.

A preliminary amendment was mailed by Applicants on January 3, 2000. In this amendment claims 2, 3, 24-52, 54-55, 64 and 82-119 were canceled, claims 1, 8, 10, 15, 23, 53, 56-63, 65-71, 73-81 and 120 were amended, and claims 121-125 were added.

A final Office action was mailed by the USPTO on February 23, 2000 (attached hereto as **Exhibit A**). This final Office action indicated that it was in response to the communication filed December 2, 1999 and, therefore, did not account for the preliminary amendment mailed on January 3, 2000.

On September 1, 2000 a non-final Office action was subsequently mailed by the USPTO (attached hereto as **Exhibit B**). In this Office action, there were three clear indications that the action was not final: First, the "final action" box was not checked on the Office Action Summary page; second, Examiner Chen stated that "[t]he office action dated 2/23/00 is vacated in favor of the following office action" (See page 1); and third, there was no language in the conclusion of

COPY

the Office action which characterized this action as a final action (compare the conclusion section of **Exhibits A and B**).

The Applicants mailed a response to the September 1, 2000 Office action, accompanied by the appropriate extension fee, on March 1, 2001.

III. The Holding of Abandonment

A Notice of Abandonment was mailed on May 8, 2001 indicating that no response was received in response to the Office action of September 1, 2000 (See Paper 18).

A petition to withdraw the holding of abandonment, under 37 C.F.R. § 1.181(a), was subsequently mailed by the Applicants on June 25, 2001. This petition indicated that a response to the non-final Office action was in fact submitted on March 1, 2001.

A Decision on the above petition was mailed by the USPTO around August 23, 2001 (attached hereto as **Exhibit C**). In this decision, the petition to withdraw the holding of abandonment was denied. However, in this decision the following determinations were made: (1) “[o]n September 1, 2000, a non-final Office action was mailed to applicants which vacated the February 23, 2000 Office action;” (2) the response mailed March 5, 2001 (referred to above as the response filed March 1, 2001) was received and timely filed; and (3) the response of March 5, 2001 was considered not fully responsive to the non-final Office action of September 2000.

In response to this decision, Applicants mailed a Petition to Revive, under 37 C.F.R. § 1.137(b), for unintentional abandonment on November 7, 2001 (attached hereto as **Exhibit D**). An Amendment, which is distinct from the Applicant's response of March 1, 2001, and is earnestly believed to be a *bona fide* response to the non-final Office action of September 1, 2000, accompanied that petition (attached hereto as **Exhibit E**).

The Petition to Revive was dismissed by the Office of Petitions in an decision mailed April 24, 2002 (attached hereto as **Exhibit F**). In this decision, the Office of Petitions appears to have interpreted the Office action of September 1, 2000 as a final Office action. Respectfully, as indicated above, the evidence indicates that this was a non-final Office action. The Office action

COPY

of September 1, 2000 had no indication of finality, and, furthermore, it specifically withdrew and replaced the earlier Office action dated February 23, 2000.

As provided in MPEP § 711.03(c), the reply requirement of a petition to revive varies as to whether there is a final or non-final Office action outstanding. Due to the apparent interpretation by the Office of Petitions that a final Office action was outstanding in the above identified matter, the Office held the reply submitted as insufficient. Respectfully, because the only outstanding action in this matter was not a final (nor supplemental to a final) action, the standard for the response component of a petition to revive was met in the petition mailed on November 7, 2001.

Also, according to MPEP § 711.03(c), the required reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either (1) an argument or amendment under 37 C.F.R. § 1.111, OR (2) the filing of a continuing application under 37 C.F.R. § 1.53(b) (or a continued prosecution application under 37 C.F.R. § 1.53(d)).

Respectfully, a brief perusal through the Amendment submitted with the Petition to Revive, mailed November 7, 2001, reveals that the reply is a *bona fide* response to the non-final Office action of September 1, 2000 (compare **Exhibits A and E**). The Applicants should not be required to submit a notice of Appeal, nor a continuing application or CPA in response to a non-final Office action. The submitted Amendment clearly addresses each of the Examiner's points in the Office action mailed September 1, 2000; and, moreover, the sufficiency of the Amendment should be weighed after revival of the application.

Therefore, the Applicants respectfully assert that the Petition to Revive, as mailed on November 7, 2001, was complete as filed. Reconsideration of the decision denying this petition is respectfully requested based upon the record as a whole.

IV. Telephone Calls to the Office of Petitions and Primary Examiner on May 21, 2002

In an effort to determine the exact nature of the reasons underlying the denial of the Petition to Revive, on May 21, 2002, Applicants' authorized representative, Ms. Karen Dow,

COPY

placed a call to Examiner Congo at the Office of Petitions. During this call, Examiner Congo asserted that the USPTO - PALM system indicated that the Office action dated September 1, 2000 was a Supplemental to the Final Action. Ms. Dow then indicated that the Office action of September 1, 2000 explicitly vacated the Office action of February 23, 2000. In response, Examiner Congo indicated that Examiner Chin should be contacted to resolve the apparent conflicts surrounding this issue.

Ms. Dow proceeded to contact Examiner Chin. Examiner Chin indicated that the Applicants should comply with the requirements of, or otherwise work the situation out with, the Office of Petitions. Without the aid of the file, which was presumably with the Office of Petitions, Examiner Chin indicated that the Petitions group is supposed to review the file prior to making a decision. In addition, Examiner Chin also seemed to think that the September 1, 2000 Office action was the latest action in this matter, and that this action was probably not final.

Ms. Dow then contacted Examiner Congo to follow-up on her earlier call. During this call, Examiner Congo indicated that a Renewed Petition to Revive could be forwarded to his attention via facsimile.

V. Request For Reconsideration Requirements

In the Decision on Petition, mailed April 24, 2002, the Office of Petitions provided the elements of a grantable petition under 37 C.F.R. § 1.137(b). Based on these elements, the Office has indicated that “[a]ny renewed petition should be accompanied by a proper reply in the form of a Notice of Appeal, the filing of a continuation application or a RCE.” Further, the Office has warned that a failure to include any of these elements in a reply to the decision mailed April 24, 2002 “will be construed as an intentional delay in presenting a grantable petition.”

Although Applicants respectfully disagree with the determination that the outstanding Action in this matter is a final action, and with the response requirements of the Office of Petitions presented in the Decision on Petition, the Applicants nevertheless desire to comply with the instructions of the Office of Petitions. Therefore, a Notice of Appeal, along with the required fee, accompanies this Request for Reconsideration. However, if the decision on this Request for

COPY

Reconsideration results in the revival of the above identified application, which revival does not require the Notice of Appeal, the Applicants respectfully and formally present the following two requests: (1) a request for the refund of the appeal fee accompanying the present Notice of Appeal, and (2) a request to abandon the present Notice of Appeal. The Applicants consider these requests to be reasonable based upon the facts involved in the present matter and do not believe they should be charged the appeal fee.

VI. Conclusion

Based on the foregoing, Applicants respectfully request reconsideration of the denial of Applicant's earlier submitted Petition to Revive the above identified application. Further, the Applicants renew the request to revive this application based upon the petition submitted by Applicants on November 7, 2001.

If the Examiner has any questions, please feel free to call the undersigned, Karen Dow, at (858) 720-7960 or send a facsimile at (858) 720-5125.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 273102007800.

Respectfully submitted,

Dated: May 30, 2002

By: Karen Babiyak Dow
Karen B. Dow
Registration No. 29,684

Morrison & Foerster LLP
3811 Valley Centre Drive, Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-7960
Facsimile: (858) 720-5125